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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,070	03/03/2006	Sutisak Kitareewan	DC0266US.NP	5026
26259 7590 08/09/2010 LICATA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053				
EXAMINER MARTIN, PAUL C				
ART UNIT 1657		PAPER NUMBER		
NOTIFICATION DATE 08/09/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poireilly@licataandtyrrell.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/564,070

Applicant(s)

KITAREEWAN ET AL.

Examiner

PAUL C. MARTIN

Art Unit

1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: g.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Rebecca E. Prouty/
Primary Examiner, Art Unit 1652

DETAILED ACTION

Claim 8 is pending in this application and was examined on its merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida et al. (1996) in view of Bard et al. (1977) for reasons of record set forth in the prior action.

Response to Arguments

Applicant's arguments filed 07/20/2010 have been fully considered but they are not persuasive.

The Applicant argues that the claims are directed to the identification of an agent that both destabilizes lysosomes and increases PML/RAR α protein degradation as opposed to Yoshida et al. whom teaches that ATRA accelerates the degradation of PML/RAR α in the nonlysosomal ubiquitin-proteasome pathway and therefore there would be no motivation to determine whether lysosomes are destabilized as described by Bard et al. because Yoshida et al. allegedly provides a clear demonstration that ATRA-mediated PML/RAR α degradation is by another mechanism. Applicant asserts therefore that the Yoshida et al. reference teaches away from the present invention (Remarks, Pg. 5, Lines 16-28 and Pg. 6, Lines 1-11).

This is not found to be persuasive for the following reasons, the rejection was not based upon the teachings of the Yoshida et al. reference alone but rather the combination of Yoshida et al. and Bard et al. as discussed in the prior action. The Yoshida et al. reference was drawn to a method of identifying an agent that increases oncogenic protein degradation comprising contacting a cell expressing PML/RAR α with the anti-cancer agent ATRA and detecting whether ATRA increases PML/RAR α degradation. The method reads on instant claim 8 preamble and step ii (contacting a cell that expresses PML/RAR α with an agent and detecting whether the agent increases PML/RAR α protein degradation).

The reference is silent with regard to lysosomal destabilization and the section the Applicant references only states that, "The degradation of most cellular proteins is catalyzed by the nonlysosomal ubiquitin-proteasome pathway, which is dependent upon ATP and closely involved in the proteolysis of aberrantly generated products". Far from constituting a "teaching away" the passage merely indicates what is well known in the art. One of ordinary skill in the art would certainly recognize that if lysosomes were destabilized by ATRA, the degradation of aberrant proteins would have to proceed by another route such as the nonlysosomal ubiquitin-proteasomal pathway. Bard et al. teaches that it was known in the art at the time of the invention to contact cells with anticancer agents and detect whether the agents destabilize lysosomes as determined by the release of lysosomal proteins into the cytosol (Reading on claim 8 preamble and step i). Therefore, it would have been obvious to one of ordinary skill in the art to combine the two methods for screening for properties of anti-cancer agents into a single method for performing the same purpose.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL C. MARTIN whose telephone number is (571)272-3348. The examiner can normally be reached on M-F 12pm-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Martin
Examiner
Art Unit 1657

08/03/2010